

REMARKS

Claims 21-40 are pending in the present application.

Claims 21-25 and 31-35 have been rejected.

Claims 26-30 and 36-40 have been objected to.

Reconsideration of the claims is respectfully requested in view of the following arguments.

In Sections 1 and 2 of the July 20, 2004, Office Action, the Examiner rejected Claims 21-25 and 31-35 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,625,132 to *Boettger et al.* (hereafter, simply "*Boettger*") in view of United States Patent No. 5,722,078 to *Przelomiec* (hereafter, simply "*Przelomiec*"). The Applicants respectfully traverse the rejection of Claims 21-25 and 31-35.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant

of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

The Applicants direct the Examiner's attention to Claim 21, which contains following unique and novel limitations:

21. A multi-mode mobile station comprising:
 - a radio frequency (RF) module capable of accessing a first radio system using a preferred radio protocol and further capable of accessing a second radio system using a less-preferred radio protocol; and
 - processing circuitry associated with said RF module capable of determining the quality of first control channel signals received from said first radio system and determining the quality of second control channel signals received from said second radio system, wherein said processing circuitry, in response to a determination that the quality of said first control channel signals is sufficient to prevent said multi-mode mobile station from losing access to said first radio system, further determines

from the quality of said first control channel signals whether said first radio system is able to provide an optimum signal quality. (emphasis added)

Independent Claim 31 recites analogous limitations. The Applicants respectfully assert that the above-emphasized limitations are not disclosed, suggested, or even hinted at in the *Boettger* reference or the *Przelomiec* reference, or in the combination of the *Boettger* and *Przelomiec* references.

The Office Action asserts that the *Boettger* reference, in several passages, describes processing circuitry that “determines from the quality of the first control signals whether the first radio system is able to provide an optimum signal quality, in response to a determination that the quality of the first control channel signals is sufficient to prevent the multi-mode station from losing access to the first radio signal.” In the pertinent cited passage at column 5, lines 34-43, the *Boettger* references states:

Thus, according to the present invention, additional criteria are employed to determine when the mobile station is entering the dead zone 110. Not only does the mobile station employ threshold. (EC_IO_THRESH) employed to investigate the quality of Ec/Io, the mobile station also employs a threshold (EC_THRESH) to investigate the quality of Ec. When one or more of these thresholds are passed, the mobile station initiates system reselection so that it may become active within the neighboring wireless communication, i.e., register with base station 106 and operate within cell 108. (emphasis added)

The Applicants respectfully submit that *Boettger*, in fact, describes a mobile station that makes only a single determination: i.e., whether either of two quality thresholds has been violated. If a violation of either quality threshold is found, the mobile station begins the system reselection process.

As such, the *Boettger* reference does not disclose, suggest or even hint at circuitry that determines whether signal quality is sufficient to prevent loss of access to a radio system and then further determines whether the radio system is able to provide an optimum signal quality. Nor does the *Przelomiec* reference teach such circuitry. This being the case, independent Claims 21 and 31 present patentable subject matter over the *Boettger* and *Przelomiec* references. Additionally, dependent Claims 22-25 and 32-35, which depend from Claims 21 and 31, respectively, contain all of the unique and novel limitations recited in independent Claims 21 and 31. Claims 22-25 and 32-35 are therefore also patentable over the *Boettger* and *Przelomiec* references.

The Applicant thanks the Examiner for the indication in Section 3 of the July 20, 2004, Office Action that Claims 26-30 and 36-40 would be allowable if rewritten in independent form including all the limitations of their base claims and any intervening claims. Because Applicant believes Claims 26-30 and 36-40 depend from allowable base claims, Applicant has not rewritten Claims 26-30 and 36-40.

SUMMARY

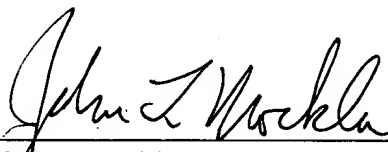
The Applicants respectfully request reconsideration and allowance of pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,
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